

## **REMARKS/ARGUMENTS**

### **I. Concerning the Amendments**

Claims 1 and 35 are cancelled without prejudice to including these claims in a subsequent continuation application, and claims that depended from Claim 1 are amended to change their dependencies as a result of the cancellation of Claim 1.

### **II. Concerning the Provisional Double Patenting Rejection**

Applicants elect to defer treatment of this provisional rejection until such time as Examiner identifies allowable subject matter in this application.

### **III. Concerning the Citation of Additional References**

Applicants previously cited the presence of several copending applications. As a precaution, even though Examiner could already be aware of references cited in the files of those copending applications, such references that recently appeared in the record of any of those copending applications and that are not of record in this application are included on a Form PTO/SB/08A attached to an Information Disclosure Statement filed herewith. The following table is provided for Examiner's convenience.

Attorney Docket No.	Serial No.	Examiner	Status
61590A	10/257,172	J. Fortuna	Pending
62733C	10/687,324	K.Bareford	Pending
62738C	10/687,322	J. Fortuna	Pending
62739C	10/691,890	K.Bareford	Pending

### **IV. Concerning the Rejection over Prior Art**

Applicants acknowledge the withdrawal of prior art-based rejections from the previous office action.

The invention is directed to a process of producing a coated paper or paperboard, other than photographic papers, using coating compositions containing pigments that do not produce suitable coatings on blade type, bar or rod type, or

reverse-roll type paper coating machines. Four independent claims are pending in the application.

Claim 3 contains the phrase "curtain comprises at least one pigment, the morphology and structure of which is destroyed at a shear rate of less than  $500,000 \text{ s}^{-1}$ " and thus relates to the use of a curtain comprising at least one fragile pigment.

Claim 4 includes the phrase "whereby a composition forming at least one layer of the free flowing curtain has a Shear-Thickening Index, defined as the ratio of the viscosity at  $30,000 \text{ s}^{-1}$  to the viscosity at  $3,000 \text{ s}^{-1}$  at  $25^\circ\text{C}$ , of at least about 1.2" and relates to the use of a curtain having a Shear-Thickening Index of at least about 1.2.

Claim 34 includes the phrase "whereby a composition forming at least one layer of the free flowing curtain has a Shear-Blocking Behavior." Shear-Blocking Behavior is defined in the specification at the bottom of page 7.

Claim 36 relates to a process for coating with large particle size pigments.

Applicants submit that the paper and paperboard coating processes of the prior art did not employ such coating compositions in view of the difficulty of producing acceptable coatings with such compositions.

A. Hirabayashi-Based Rejections

Claims 1-19, 22-25, 29-32 and 34-37 stand rejected under 35 USC 103(a) as being unpatentable over Hirabayashi et al. (US 5,789,031, hereinafter Hirabayashi '031) in view of Clarke et al. (US 6,099,913, hereinafter Clarke) or Suga et al. (US 5,393,571, hereinafter Suga).

Claims 1-19, 22-25, 29-32 and 34-37 stand rejected under 35 USC 103(a) as being unpatentable over Hirabayashi et al. (US 6,458,413, hereinafter Hirabayashi '413) in view of Clarke or Suga.

Unless otherwise indicated, Applicants at the present time elect to address the patentability of the independent claims, and for the purposes of this response the patentability of the dependent claims stands or falls together with the patentability of their relevant independent claim.

The invention of the Hirabayashi '031 reference is directed to a post-treatment step, and is not concerned with how the "normal" coating process is conducted, since the normal coating process is merely a precursor to the process of Hirabayashi '031. The Hirabayashi '031 reference contains a boilerplate paragraph referring to known techniques for applying aqueous pigmented coating compositions to base paper. However, there is no appreciation of the subject matter of Applicants' claims in Hirabayashi '031.

Hirabayashi '413 is directed to making a coated paper wherein the manufacturing process includes a pretreating step wherein an aqueous solution of polyvinyl alcohol is applied and dried to form a base paper. The purpose of the polyvinyl alcohol precoat is to increase the air resistance of the base paper. The Hirabayashi '413 reference teaches that the resulting pretreated base paper can be subsequently coated using conventional coating techniques.

In view of the fact that Hirabayashi '413 contains the same or essentially the same boilerplate language regarding coating processes and pigments as the boilerplate language of the Hirabayashi '031 reference, the two Hirabayashi references are viewed as being cumulative in nature and Applicants will address the two rejections as one.

Examiner's rationale, as explained in the current office action, relates to the viscosity limitations of Claim 1. However, in view of the cancellation of Claim 1, that rationale is no longer applicable. For example, Claim 4 specifies that a composition forming at least one layer of the free flowing curtain has a Shear-Thickening Index of at least 1.2. The Hirabayashi references do not discuss viscosity. However, the record contains a declaration of Dr. Michael J. Devon indicating that the Shear-Thickening Index of the coating composition of Hirabayashi '031 Embodiment 1 was 0.577, which is far less than the value of 1.2 specified by Applicants' Claim 4. Clarke does not show any shear thickening compositions, in other words, the Shear-Thickening Index of the compositions of Clarke are less than 1. This is clearly seen in Figure 5 of Clarke, which shows that for three compositions the viscosity at  $30,000 \text{ s}^{-1}$  is lower than the viscosity at  $3,000 \text{ s}^{-1}$ . Regarding Suga, it is interesting to note that the teaching of Suga is summarized in Clarke at column 3. Clark states as follows at

column 3, lines 29-34: "Suga et al. teach increasing the viscosities of coating compositions for the purposes of their method by the addition of a thickening agent that interacts with the binder in the composition, i.e. gelatin, to increase the viscosity at low shear rate without substantially increasing its viscosity at high shear rate ... ." It is clear from this passage of Clarke that Suga does not disclose coating compositions having a Shear-Thickening Index of greater than 1. Accordingly, Applicants submit that the subject matter of Claim 4 is not obvious, and request reconsideration of this rejection.

Claim 34 includes the phrase "whereby a composition forming at least one layer of the free flowing curtain has a Shear-Blocking Behavior." As mentioned in the specification at the bottom of page 7, Shear-Blocking Behavior is determined by observing an increase in viscosity of greater than about 100% over less than a tenfold increase in shear rate, where the viscosity values are measured using the Parallel Plate Viscosity Test defined in the specification. No coating composition with this behavior is identified in Hirabayashi, Clarke or Suga for the reasons given above in connection with Claim 4. Rather, the prior art compositions exhibit a decrease in viscosity with increasing shear rate as shown in Clarke Figure 5.

Claim 3 contains the phrase "curtain comprises at least one pigment, the morphology and structure of which is destroyed at a shear rate of less than  $500,000 \text{ s}^{-1}$ " and thus relates to the use of a curtain comprising at least one fragile pigment. The Hirabayashi references only disclose pigments that are usually used in paper coating, such as standard clay and calcium carbonate. Hirabayashi does not relate to the use of fragile pigments. Clarke and Suga disclose compositions that do not contain any mineral pigments. Therefore, it is respectfully submitted that the subject matter of Claim 3 is not obvious, and reconsideration of this rejection is requested.

Claim 36 relates to a process for coating with compositions having a median particle size of at least  $2 \mu\text{m}$ . Such compositions are unsuitable for coating using traditional paper coating apparatus, such as rod coaters, since the use of such large pigments would result in coating defects. As mentioned hereinabove, Clarke and Suga disclose compositions that do not contain any mineral pigments, and Hirabayashi merely discloses pigments that are usually used in paper coating. Applicants submit

that the subject matter of Claim 36 is not obvious since compositions having a median particle size of at least 2  $\mu\text{m}$  are not normally used in paper coating, and since nothing in the prior art would suggest the process of Claim 36.

B. The Yokota-Based Rejection

Claims 1-20 and 22-37 stand rejected under 35 USC 103(a) as being obvious over Yokota in view of Kustermann, Suga or Clarke, with or without Mitani et al. (US 5, 773, 093, hereinafter Mitani).

Yokota teaches a reactive coating process conducted using a relatively low solids curtain. The problem addressed by Yokota is poor layer purity due to intermingling of layer components caused by water transport phenomena in low solids coatings in the direction of the base paper, i.e. the base paper absorbs water. Yokota's solutions to limit water transport towards the base paper were as follows: (1) to use an isolating layer between two curtain layers that increase in viscosity when contacted with each other; (2) to use 2 adjacent layers that increase in viscosity over time when brought into contact with each other or mixed; (3) to precoat the substrate with water; or (4) to apply an interface layer of at least 90% water between the base paper and the other layers of the curtain. At column 2, lines 38-64 Yokota explains that photographic coatings contain gelatin, and that said coatings are cooled immediately upon coating to set the coating so that no intermingling of the coating layers possible. He further explains that for his applications gelatin causes problems, as it degrades various properties of his coating materials. He also explains that, unlike photosensitive materials, most of his materials use a substrate that readily absorbs water. At column 5, lines 52-3, he explains that intermingling of layers results in unsatisfactory products. At column 6, lines 6-10 he teaches that his process prevents intermingling of layers.

Examiner cites Mitani and Kustermann, and possibly Yokota, for the proposition that any material can be successfully applied using a curtain coater. However, that proposition is clearly rebutted by Clarke and Suga. Both Clarke and Suga go into great detail regarding successful coating regions or coating windows. As such, they must be given more weight than either Mitani or Kustermann. Both Mitani

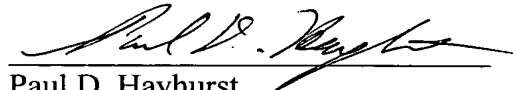
and Kustermann merely contain broad, generic statements regarding coating conditions because both of these references are directed to mechanical accessories to curtain coating apparatus and are not concerned with coating compositions. Accordingly, Applicants respectfully submit that any combination of Yokota, Clarke, Suga, Mitani and Kustermann does not render any of the pending claims obvious.

Clarke and Suga indicate that the curtain coating process is a complex combination of chemical and mechanical components involving a nearly limitless combination of possibilities, and a wide variety of parameters that can be varied. As such, Applicants respectfully submit that the claims contained in the present application are not obvious over the prior art, which neither teaches nor suggests their subject matter.

V. Conclusion

For the foregoing reasons, reconsideration of the claims and passing of the application to allowance are solicited.

Respectfully submitted,



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